

REMARKS

A restriction requirement was made in the Office Action mailed March 13, 2008. Within the restriction requirement, a restriction was made based Group I directed to apparatus claims (claims 21-34) and Group II directed to method claims (claims 35-40). The Applicants elect Group I without traverse.

In addition, the restriction requirement states that the claims are directed to more than one species of the generic invention and has based those species on Figures. The Applicants respectfully traverse. Applicants **provisionally** elect the recited claimed subject matter of Claims 21-28, and 31-34 and Species C.

The provisionally elected Claims 21-28, and 31-34 and Species C may read on one or more of the drawing figures identified in the restriction requirement other than Figures 12-14, and none of these claims is necessarily restricted to drawing figures 12-14. The Applicants have withdrawn Claims 29 and 30, and have added new Claims 41-44 which are readable upon the subject matter in currently pending Claims 21-28, and 31-34.

It will be recalled that the statutory basis for restriction requirements refers to **claims**, not drawing figures. 35 U.S.C. §121 states that “If two or more independent and distinct inventions are **claimed** in one application, the Director may require the application to be restricted to one of the inventions.” (Emphasis added) Consistent with this requirement, the Manual of Patent Examining Procedures (M.P.E.P) instructs Examiners to base a restriction on the **claims**. Some excerpts from Chapter 800 of the M.P.E.P., which governs restriction practice, are the following:

In passing upon questions of double patenting and restriction, it is the **claimed** subject matter that is considered and such **claimed** subject matter must be compared in order to determine the question of distinctness and independence. M.P.E.P. § 806.01. (Emphasis added).

Where the **claims** of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. M.P.E.P. § 806.03 (Para. 1). (Emphasis added).

Where an applicant files a divisional application claiming a species previously **claimed** but nonelected in the parent case . . . there should be no determination of whether or not the species **claimed** in the divisional application is patentable over the species retained in the parent case since such a determination was made before the requirement to restrict was made. M.P.E.P. § 806.04(h) (Para.1). (Emphasis added).

[T]he Examiner should not require restriction to a reasonable number of species unless he or she is satisfied that he or she would be prepared to allow **claims** to each of the **claimed** species over the parent case, if presented in a divisional application. M.P.E.P. § 806.04(h) (Para. 2).

The form Outline of Letter for Restriction requires the Examiner to, “List **claims** in each group.” M.P.E.P. § 817 Outline of Letter (a)(2).

In addition, under M.P.E.P. § 808, every restriction requirement has two requirements which must be presented by the Examiner to provide a prima facie case for a proper restriction requirement. These are (a) reasons, as distinguished from the mere statement of conclusions, must be provided by the Examiner as to why each invention as claimed is either independent or distinct from the other; and (b) the reasons must be provided as to why there would be a serious burden on the Examiner if the restriction is not required.

Under M.P.E.P. § 808.01, the particular reasons relied on by the Examiner for holding that the claimed invention(s) are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. In addition to this requirement, M.P.E.P. § 808.01 states in applications where only generic claims are presented, restriction cannot be required unless a generic claim covers such a multiplicity of species that an unduly extensive and burdensome search would be necessary to search the entire scope of the claim. Therefore, the Examiner must

show one of the following: that there is a separate classification between the distinct inventions; that a separate status in the art is applied to each invention even though they may be classified together; or that it is necessary to search different fields of art for the distinct inventions. In the present case, the Examiner has not provided any of the above support to establish that the restriction based on Figures is required. Accordingly, the Examiner has not satisfied a *prima facie* case of showing that a restriction requirement is warranted. For at least these reasons, the restriction requirement based on Figures should be withdrawn.

The Applicants also traverse the Restriction Requirement on the basis that the identification of species based upon figures unduly limits the scope of protection of any of the elected species. Should any of the current claims, or any claims added later in prosecution, be deemed by the Patent Office or a court to be read under 35 U.S.C. 112, paragraph 6, then those claims would be potentially limited to the embodiment shown in the elected figure(s). However, election of a species based on a figure(s), where all other species are also identified by a figure(s), has the effect of "removing" from the specification all figures not identified as being a part of the elected species. This is even more important in the present application because several claims include "means for" language under 35 U.S.C. 112, paragraph 6. Accordingly, Applicants respectfully refrain from electing one or more Figures and request the examiner to review the elected claims.

Should the Examiner elect to maintain the present Restriction Requirement or otherwise reject this application finally or non-finally for the Applicant's refusal to elect a figure for prosecution, then this paper is to be treated as a petition to the Director under 37 C.F.R. §1.183 to waive such rules as necessary, in the interests of justice, to prevent an unnecessary extinguishment of the Applicant's rights as detailed above. Any fees associated with the petition may be charged to our deposit account as set forth below. The Applicant reserves the right to

pursue the claims of any other species in a divisional application and rejoin withdrawn claims upon allowance of a generic claim.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account 50-1698.

Respectfully submitted,
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